

cancers being treated are susceptible to treatment with the compounds recited in the claim, while claim 3 has simply been amended to delete references to "claim 2".

Concerning cancelled claims 9-12, they have been cancelled, since they were previously withdrawn from consideration by the Examiner under 35 USC § 1.142(b).

***Rejection Under 35 USC § 103***

In the outstanding Office Action, claims 1, 3-4 and 13-15 were rejected under 35 USC § 103 as being unpatentable over Wu et al. [Cancer Research 49, pages 3754-3758, July 15, 1989]. Reconsideration and withdrawal of this rejection are respectfully requested based upon the following considerations.

**Knazek Declaration**

Accompanying the present Amendment is an unsigned 37 CFR § 1.132 Declaration of Dr. Richard Knazek, who is one of the present co-inventors and a co-author on the cited Wu et al. reference. The Examiner is respectfully requested to review Dr. Knazek's Declaration at this time, since it is material to the Examiner's outstanding rejection under 35 USC § 103. A signed copy of Dr. Knazek's Declaration will be submitted to the USPTO once it is received by the undersigned.

In Dr. Knazek's Declaration, he clarifies that his co-authors on the accompanying Wu et al. reference (Drs. Wu and Chik) are not

co-inventors of the subject matter claimed in the matter of the above-identified application. Dr. Knazek also makes clear Mary R. Flack, Marcus Reidenberg and himself are the sole co-inventors of the subject matter disclosed and claimed in the instant application.

Further to the above, Dr. Knazek's Declaration also clarifies that any disclosure occurring in the cited Wu et al. reference, that pertains to certain embodiments of the present invention, was a disclosure by Dr. Knazek, himself, of subject matter which he (as one of the present co-inventors) ultimately disclosed and claimed in the above-identified application. The Declaration also makes clear that this disclosure by Dr. Knazek was made within one year of the filing date of U.S. patent application Serial No. 07/551,353 (i.e., July 12, 1990), upon which priority for the present application is claimed under 35 USC § 120.

It is noted that the probative value of Dr. Knazek's accompanying Declaration is not weakened by the fact that Dr. Knazek is the sole declarant thereof. In this regard, see Ex parte Magner, 133 USPQ 404 (POBA 1961), In re Katz, 215 USPQ 14 (CCPA 1982), both of which cases support the appropriateness of Dr. Knazek's Declaration for overcoming the outstanding rejection under 35 USC § 103 over Wu et al.

Accordingly, upon properly considering Dr. Knazek's Declaration, it will be clear that the cited Wu et al. reference is incapable of rendering the claimed invention obvious under 35 USC

§ 103, since at best it only contains a disclosure by one of the present co-inventors made within one (1) year of the earliest filing date upon which the present inventors claim priority under 35 USC § 120, Shields v. Halliburton et al., 216 USPQ 1066 (CA 5th, 1982), In re Katz, *supra*.

Based upon the above considerations, the Examiner is respectfully requested to withdraw the outstanding prior art rejection over the cited reference of Wu et al.

***Rejection Under 35 USC § 112, First Paragraph***

In the outstanding Office Action, claims 1 and 13 were rejected under 35 USC § 112, first paragraph. Reconsideration and withdrawal of this rejection are respectfully requested based upon the following considerations.

In the outstanding Office Action, the Examiner cites several sections of the MPEP (6<sup>th</sup> ed.) in support of the 35 USC 112, first paragraph rejection (i.e., MPEP 706.03(n) and 706.03(z)). However, the sections of the MPEP cited by the Examiner are concerned with promoting correspondence between an Applicant's claims and his disclosure (MPEP 706.03(n)), or avoiding the problem of "undue breath" in claim scope, neither of which problems are engendered by the language of the present claims. For example, claims 1, 13, 16 and 18 each correspond to disclosure set forth in the application at page 3, line 12 to page 4, line 3, and at page 14, lines 6-25, so that no problem exists with the correspondence

between the present claim scope and the applicants' original disclosure. Similarly, no problem of "undue breath" exists, since (i) claim 1 has been amended to recite that the cancers being treated are "susceptible to treatment with gossypol, gossypolone, or physiologically acceptable salts thereof", and (ii) exemplary cancers encompassed by the claims are fully set forth at page 14 of the specification. Further to the above, the Examiner is reminded that the issue of "claim language definiteness" must be analyzed - not in a vacuum, but always in light of the applicant's disclosure as it would be interpreted by one possessing an ordinary level of skill in the pertinent art field, In re Moore, 169 USPQ 236 (CCPA 1971); and that the issue of claim breath is determined by whether the claims are, in fact, reasonable definitions of the disclosed invention, In re Rainer 153 USPQ 802 (CCPA 1967). Thus, under the holdings of each of these cases, it is submitted that each of the pending claims is both allowable and patentable under the provisions of 35 USC § 112, first paragraph.

Accordingly, withdrawal of the outstanding rejection under 35 USC § 112, first paragraph, is required.

#### **CONCLUSION**

Based upon the amendments and remarks presented herein, as well as the submission of the accompanying 37 CFR 1.132 Declaration of Dr. Knazek, the Examiner is respectfully requested to issue a Notice of Allowance in the matter of the above-identified

application clearly indicating that each of pending claims 1, 3-4 and 13-15 is allowed and patentable under the provisions of Title 35 of the United States Code.

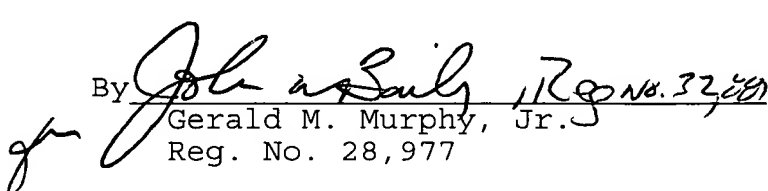
Should the Examiner have any questions regarding this matter, he is respectfully requested to contact Mr. John W. Bailey (Reg. No. 32,881), who may be reached in the Washington, DC, area at (703) 205-8000.

Pursuant to 37 CFR 1.17 and 1.136(a), Applicants respectfully petition for a two (2) month extension of time for filing a response in connection with the present application, and the required fee of \$380.00 is attached hereto.

Please charge any fees or credit any overpayment pursuant to 37 CFR § 1.16 and 1.17 to Deposit Account No. 02-2448.

Respectfully submitted,

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